




Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) SHO-0051	
	Application Number 10/697,084-Conf. #9737	Filed October 31, 2003	
	First Named Inventor Tatsuhiko TANIMURA		
	Art Unit 3714	Examiner M. J. Thomasson	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,211</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <div style="text-align: right;"> _____ Signature _____ Carl Schaukowitch Typed or printed name _____ (202) 955-3750 Telephone number _____ February 20, 2008 Date</div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of <u>1</u> form is submitted.</p>			



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:
Tatsuhiko TANIMURA
Application No.: 10/697,084
Filed: October 31, 2003
For: GAMING MACHINE

Attorney Docket No.: SHO-0051
Examiner: M. J. Thomasson
Art Unit: 3714
Confirmation No.: 9737

ARGUMENTS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Examiner issued an Advisory Action dated January 25, 2008, in response to Applicants' Response to Final Office Action under 37 CFR 1.116 filed on December 27, 2007. Applicant's Response to Final Office Action was filed in response to the final Office Action dated October 31, 2007. A complete listing of the claims and the appropriate status identifiers can be found in Applicant's Response to Final Office Action on pages 2-4. No amendments were made to the claims, i.e., claims 1-10, in Applicant's Response to Final Office Action.

Claims 1, 2, 4, 6-8 and 10 are rejected under 35 USC 103 (a) as being unpatentable over Ozaki (U.S. Patent Application Publication No. 2001/0031658) in view of Satoh et al. (U.S. Patent No. 6,811,273). Claims 3 and 5 are rejected under 35 USC 103 (a) as being unpatentable over Ozaki, Satoh and further in view of Weiss (U.S. Patent No. 6,623,006). Claim 9 is rejected under 35 USC 103 (a) as being unpatentable over Ozaki, Satoh and further in view of Niwa (U.S. Patent No. 6,790,140). The rejections are respectfully traversed.

In the previous Office Action, the Examiner raised §103 rejection of claim 1 based on the combination of the following three configurations:

1. Fig. 2 of Ozaki (US'658): EL panel + opening on the intermediate panel 27
2. Fig. 28 of Ozaki: LCD panel + semi-transparent reflective plate 25
3. Satoh (US '273): opening on the transparent frame member 10

In summary, Applicant had argued the Examiner's rejection as follows in the previous response:

It is respectfully submitted that a skilled person would NOT be motivated to provide an opening on the semi-transparent reflective plate 25 of the second configuration (with LCD panel). Accordingly, a skilled person would NOT be motivated to combine the second configuration with the first or the third configuration.

And yet, the Examiner maintains his §103 rejection by mentioning that Satoh discloses the transparent frame member 10 being formed with an opening. It is respectfully submitted that it appears the Examiner is unduly oversimplifying Applicant's previous arguments and has apparently not examined the Applicant's previous arguments to a reasonable extent.

Accordingly, the Applicant respectfully requests reconsideration of the application and Remarks set forth herein above and in the previously-filed Amendment.

For convenience of the Panel, Applicant hereby reiterates the Remarks set forth in the previously-filed Amendment under 37 CFR 1.111 filed on August 20, 2007:

The Office Action admits that Ozaki (US'658) fails to disclose any cutouts or recess formed in the light guiding plate in the configuration shown in Fig. 28, which is an embodiment using an LCD panel, while pointing out that the cutouts are disclosed in the configuration shown in Fig. 2 of Ozaki, which is another embodiment using an EL panel.

It is clearly described in Ozaki that the intermediate panel 27 shown in Fig. 2 is opaque (c.f. paragraph [0045]). The cutouts are formed on the intermediate panel 27 so that the reels 30 could be seen through the opaque intermediate panel 27 and through the transparent EL panel 28.

It should be noted here that an EL panel is a spontaneous luminescent type device that does not require backlight in displaying an image.

In the alternative embodiment shown in Fig. 28, the semi-transparent reflective plate 25 is disposed to provide a backlight to the LCD panel 24. A skilled person would not be motivated to form a cutout, like the one formed on the opaque intermediate panel 27, on the semi-transparent reflective plate 25 that is already semi-transparent as shown by the arrows in Fig. 28.

A skilled person would also not be motivated to do so by a reason that, if a cutout is formed on the plate 25, the backlight would not be provided to the LCD panel at the cutout when the back side display device 2 is made dark as described in paragraph [0139], causing the image displayed by the LCD panel damaged.

Accordingly, it is respectfully submitted that a skilled person would not be motivated to form a cutout on the plate 25 as such disclosed in a different embodiment of Ozaki or in Satoh (US 273). Therefore, it is respectfully submitted that the claimed invention would not be obvious from the combination of Ozaki and Satoh.

At least for the reasons set forth above, withdrawal of the rejections is respectfully requested.

Newly-added claim 10 also includes features not shown in the applied art. In brief, the new independent claim 10 recites all the subject matter recited in claim 4 and the feature "the light guiding plate illuminates the reels with light scattered out from the cutout or the recess".

Satoh discloses a configuration to guide light emitted from the cutout face of the transparent frame member 10 toward a direction opposite to the reels. Satoh fails to suggest illuminating the reels with light emitted from the cutout.

Weiss (US 006) discloses a configuration, if not explicitly, in which the peripheral faces of the LCD 20 are covered by a frame.

In rejecting claims under 35 U.S.C. §103, the United States Patent and Trademark Office bears the initial burden of presenting a *prima facie* case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. "A *prima facie* case of obviousness is established if the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." In re Bell, 991 F.2d 781, 782, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) quoting In re Rinehart, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1776). The mere fact that the prior art *may* be modified in the manner suggested by the Examiner neither makes the modification *prima facie* obvious or obvious unless the prior art suggested the desirability of the modification. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led the individual to combine the relevant teachings of the references to arrive at the claimed invention.

Furthermore, in addition to the TSM test mentioned immediately above, Examiners can make appropriate rejections regarding the obviousness of claimed inventions in light of the recent Supreme Court's decision in KSR International Co. v. Teleflex Inc., 550 U.S. ___, 82 USPQ2d 1385 (2007). The familiar factual inquiries announced by the Supreme Court in its much earlier decision, Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), remain the basis for every decision regarding obviousness, i.e., Examiners will continue to consider:

- (1) the scope and content of the prior art,
- (2) the differences between the claimed invention and the prior art,
- (3) the level of ordinary skill in the pertinent art, and
- (4) objective evidence relevant to the issue of obviousness.

It is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness either under the TSM test or the criteria under Graham v. John Deere Co. *supra*.

Withdrawal of the rejections is respectfully requested.

In view of the foregoing, reconsideration of the application and allowance of the pending claims are respectfully requested. Should the Examiner believe anything further is desirable in order to place the application in even better condition for allowance; the Examiner is invited to contact Applicants' representative at the telephone number listed below.

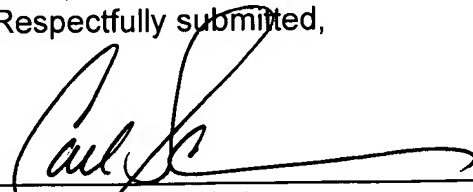
Should additional fees be necessary in connection with the filing of this paper or if a Petition for Extension of Time is required for timely acceptance of the same,

the Commissioner is hereby authorized to charge Deposit Account No. 18-0013 for any such fees and Applicant(s) hereby petition for such extension of time.

Respectfully submitted,

Date: February 20, 2008

By:


Carl Schaukowitch
Reg. No. 29,211

RADER, FISHMAN & GRAUER PLLC
1233 20th Street, N.W. Suite 501
Washington, D.C. 20036
Tel: (202) 955-3750
Fax: (202) 955-3751
Customer No. 23353

Enclosure(s): Notice of Appeal
 Pre-Appeal Brief Request for Review
 Petition for Extension of Time (one month)

DC304815.DOC